

REMARKS

Claims 42 to 45, 47 to 72 and 74 are pending and being considered (since claims 31 to 41 were previously withdrawn in response to a restriction requirement).

Applicants respectfully request reconsideration of the present application in view of this response.

With respect to page two (2) of the Final Office Action, claims 42 to 45 and 47 to 71 were rejected under the first paragraph of 35 U.S.C. Section 112 as to the written description requirement.

The Office bears the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.” (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added).

It is respectfully submitted that the Final Office Action's arguments and assertions simply do not identify why the rejected claims are not supported by the written description of the present application (and its specification) — which it plainly is, as explained herein.

The Manual of Patent Examining Procedure specifically provides that if the Office rejects a claim based on the lack of a written description, the examiner should “identify the claim limitation not described” and also provide “*reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.*” (See id.).

In this regard, the Final Office Action does not explain why a person skilled in the art would not recognize the exclusionary feature of claim 42. The Final Office Action also does not even address (let alone refute) the fact that since, for example, the specification (see pages 3 to 5) specifically discusses the reflected power problem, makes plain that it solves this problem by using, for example, frequency variation, so that there is no reference to solving the problem by using the prior reference approach of measuring the ratio of magnitudes of applied and reflected power of the generator -- which the Final Office Action only conclusorily asserts would have been known by those skilled in the art.

As stated by the Board in Ex parte Harvey, 3 U.S.P.Q. 2d 1626, 1627 (Bd. Pat. App. Int. 1986) (emphasis added, citations omitted):

Compliance with the written description requirement of Section 112 only requires that appellant's application contain sufficient disclosure, *expressly or inherently*, to make it clear to persons

skilled in the art that appellant possessed the subject matter claimed. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the claimed subject matter, *rather than the presence or absence of literal support in the specification for the claimed language.*

Likewise, as stated by the Board in Ex parte Sorenson, 3 U.S.P.Q. 2d 1462, 1463 (Bd. Pat. App. Int. 1987) (emphasis added):

[W]e are mindful that appellant's specification need not describe the claimed invention in *ipsis verbis* to comply with the written description requirement. *The test is whether the originally filed specification disclosure reasonably conveys to a person having ordinary skill that applicant had possession of the subject matter later claimed.* . . . Moreover, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in appellant's specification disclosure a description of the invention defined by the claims.

In particular, the Sorenson Board, noting that the examiner only essentially stated that the claim expressions at issue did not “appear in the original disclosure” and that the claim expressions were therefore “not adequately supported by the few specific compounds in the specification”, found that the examiner had not met his initial burden of “presenting evidence why a person having ordinary skill in the art would not recognize in appellant's specification a description of the invention defined by the claims” — and that the “only reasoning presented” that the Board could discern was an “example of *ipse dixit* reasoning, resting on a bare assertion by the Examiner”.

In view of all of the foregoing, it is respectfully submitted that the Final Office Action's arguments and assertions do not satisfy the evidentiary and judicial standards discussed above, and it is respectfully submitted that the Final Office Action does not establish a prima facie written description case with respect to the present application. It is therefore respectfully submitted that the present application does satisfy the written description requirement of 35 U.S.C. § 112. Accordingly, it is respectfully submitted that the “written description” rejection of the claims should be reversed.

It is therefore respectfully submitted that the Final Office Action's arguments and assertions simply do not explain why the subject matter of the rejected claims is not

supported by the written description of the present application — which it plainly is for the reasons explained herein.

Accordingly, claim 42 is allowable, as are its dependent claims 43 to 45 and 47 to 71.

Claim 74 was rejected under 35 U.S.C. § 103(a) as obvious over Kadomura, U.S. Patent No. 5,662,819 in view of Collins et al., U.S. Patent No. 6,217,785, Wilbur, U.S. Patent No. 6,020,794, and Koshimizu, U.S. Patent No. 5,997,687.

Independent claim 74 is supported by the present application (including, for example, the specification at pages 3 to 5), and includes the feature which provides that the variation of the frequency is such as to avoid high reflected powers back into the ICP coil generator when the plasma power is pulsed. This feature, as provided for in the context of claim 74, is in no way described or even suggested by any of the references applied to date.

Accordingly, claim 74 is allowable over the references applied to date, since they do not in any way disclose or suggest this feature.

As to the rejections in the Final Office Action, the rejections simply and conclusorily assert that this feature is somehow met by the combination of references -- *but provides no explanation or citations whatsoever as to how this is so*, and therefore essentially admits that the references provide no specific disclosure whatsoever as to these features of claim 74. It is respectfully submitted that any review of the references makes plain that they nowhere disclose or suggest the claim 74 features, so that claim 74 is allowable.

Claim 74 was rejected under 35 U.S.C. § 103(a) as obvious over Savas, WO 97/14177 in view of Collins et al., U.S. Patent No. 6,217,785, Wilbur, U.S. Patent No. 6,020,794, and Koshimizu, U.S. Patent No. 5,997,687.

Claim 74 is allowable over the references applied to date, since they do not in any way disclose or suggest the feature which provides that the variation of the frequency is such as to avoid high reflected powers back into the ICP coil generator when the plasma power is pulsed.

As to the rejections in the Final Office Action, the rejections simply and conclusorily assert that this feature is somehow met by the combination of references -- *but provides no explanation or citations whatsoever as to how this is so*, and therefore essentially admits that the references provide no specific disclosure whatsoever as to these features of claim 74. It is

respectfully submitted that any review of the references makes plain that they nowhere disclose or suggest the claim 74 features, so that claim 74 is allowable.

Claim 74 was rejected under 35 U.S.C. § 103(a) as obvious over Koshimizu, U.S. Patent No. 5,935,373 in view of Collins et al., U.S. Patent No. 6,217,785, Wilbur, U.S. Patent No. 6,020,794, and Koshimizu, U.S. Patent No. 5,997,687.

Claim 74 is allowable over the references applied to date, since they do not in any way disclose or suggest the feature which provides that the variation of the frequency is such as to avoid high reflected powers back into the ICP coil generator when the plasma power is pulsed.

As to the rejections in the Final Office Action, the rejections simply and conclusorily assert that this feature is somehow met by the combination of references -- *but provides no explanation or citations whatsoever as to how this is so*, and therefore essentially admits that the references provide no specific disclosure whatsoever as to these features of claim 74. It is respectfully submitted that any review of the references makes plain that they nowhere disclose or suggest the claim 74 features, so that claim 74 is allowable.

As further regards all of the obviousness rejections discussed herein, in rejecting a claim under 35 U.S.C. § 103(a), the *Office* bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Thus, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also suggest combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

Moreover, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.” (See Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998)). It is respectfully submitted that, as discussed above, the references relied on, whether taken alone or combined, do not suggest in any way modifying or combining the references so as to provide the presently claimed subject matter for addressing the problems and/or providing the benefits of the dynamic addressing feature of the claimed subject matter as explained herein and in the specification.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, it is believed that there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference relied upon makes plain that it simply does not describe the features discussed above of the claims as now presented.

Thus, the proper evidence of obviousness must show why there is a suggestion as to the reference so as to provide the subject matter of the claimed subject matter and its benefits.

In short, there is no evidence that the reference relied upon, whether taken alone or otherwise, would provide the features of the claims discussed above. It is therefore respectfully submitted that the claims are allowable for these reasons.

As further regards all of the obviousness rejections of the claims, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See *In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and any Appeals Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))).

In short, the Examiner bears the initial burden of presenting a proper *prima facie* unpatentability case — which has not been met in the present case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Accordingly, claim 74 is allowable.

In short, claims 42 to 45, 47 to 71 and new claim 74 are allowable for all of the above reasons.

CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that claims 42 to 45, 47 to 71 and 74 are allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,

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